

REMARKS/ARGUMENTS

Claims 1-20 were rejected. Claims 1-20 remain pending. Claims 1, 8, and 16 are amended herein. No new matter is added as a result of the Claim amendments.

Support for the amendments to Claims 1 and 8 can be found at least at: page 8, lines 1-21; page 9, lines 1-4; page 11, lines 19-22; page 12, line 16 - page 12, line 5; page 13, lines 19-20; page 15, lines 11-26; and Figures 2B, 3, and 4 of the application as filed. Claim 16 was amended to remedy a potential antecedent basis issue. Support for amendment to Claim 16 can be found at least at page 13, lines 15-25.

35 U.S.C. §101 Rejections

Claims 8-16 and 17-20 are rejected under 35 U.S.C. § 101.

Claims 8-16

With respect to Claims 8-16, according to page 2 of the Rejection of 07/08/2009, these claims were rejected because the 5 components recited “...appear to be software components and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The Rejection, page 2, goes on to contend that “[t]he system claims appear to be an apparatus claim in a preamble ‘a rack equipment information system’, however, there are no normal structures or function elements which are required in an apparatus claim.” Applicants respectfully disagree. Instead, Applicants submit that the components in question positively recite their physical nature as being either a physical bulk storage or a processor. For example, Claim 8 recites “an equipment description information

repository...comprising physical bulk storage coupled with a computer; a management plan information repository ... comprising a second physical bulk storage coupled with said computer; a coordination component ... implemented by a processor of said computer which is programmed with instructions for performing said coordinating; and a repository management component ... implemented by said processor of said computer which is programmed with instructions for performing said automatic retrieval and said population. Applicants respectfully submit that such physical components lie within the realm of 35 U.S.C. §101, and thus show that the rack equipment information coordination system of Claims 8-16 is not directed to non-statutory subject matter. Applicants respectfully request withdrawal of the 35 U.S.C. §101 rejection of the rack equipment information coordination system of Claims 8-16.

Claims 17-20

With respect to Claims 17-20, according to page 3 of the Rejection, these claims are rejected "... because the claims deal with a system which contains software and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition." The Rejection, page 3, goes on to contend that "[t]he system claims appear to be an apparatus claim in a preamble 'a computer system,' however, there are no normal structures or function elements which are required in an apparatus claim." Applicants respectfully submit that the specification clearly discloses structures which one of ordinary skill in the art at the time of the invention would understand to be structures for implementing the features of Claims 17-20.

For example, Figure 3 illustrates numerous modules and components (e.g., equipment description information repository 311; management plan information repository 312; cross indexing component 313; description retrieval module 321; rack equipment management plan module 322; rack equipment correlation module 323; instruction saving module 324; interface module 325; communication link 330; and repository management component 320. These modules and components are described at least by page 10, line 14 - page 14, line 25.

Additionally, Figure 4 illustrates a computer system 400 (described at least on page 15, line 1 - page 16, line 7). As indicated at page 15, line 15, “[p]rocessor 451 processes information and instructions, including instructions and information for managing rack equipment information coordination (e.g., processor 451 processes instruction for rack equipment description retrieval module 321, rack equipment management plan module 322 rack equipment correlation module 323 and instruction saving module 324, etc.). Moreover, page 9 lines 14-16 indicate that “... the rack equipment description information and the rack equipment management plan are stored on a computer readable medium.” Page 15, lines 19-22 recite that “[memory 452 stores information and instructions, including instructions for implementing rack equipment information coordination.” Page 15, lines 21-22 indicate “[b]ulk storage component 454 also provides storage of information (e.g., rack equipment description information, policy information, etc.).” Page 15, lines 24-25 indicate that “[i]nput component 453 facilitates communication of information ... to computer system 400.

In response to Applicants’ highlighting of these structures that are disclosed within the specification, and which can be utilized for implementing the features of the computer system of

Claims 17-20, Applicants respectfully request withdrawal of the 35 U.S.C. §101 rejection of the computer system of Claims 17-20.

35 U.S.C. §112 Rejections

Claims 8-16

Claims 8-16 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Specifically, the Rejection, page 4, section 6 has indicated that Claim 8's recitation of "... 'said equipment description information comprising physical bulk storage coupled with a computer' is vague and indefinite." Applicants submit that the recited passage includes an informality and should read as "... said equipment description information repository comprising physical bulk storage coupled with a computer." Appropriate correction by claim amendment has been made herein.

Additionally, Claim 8's passage "said management plan information and also controls population of said equipment description information into said equipment description information" has been noted as being vague and indefinite. Applicants submit that the recited passage includes an informality and should read as "said management plan information..., wherein said repository management component also controls population of said equipment description information into said equipment description information." Appropriate correction by claim amendment has been made herein.

Applicants submit that such amendments resolve the 35 U.S.C. §112, second paragraph, issues with respect to Claim 8. As such, Applicants respectfully request withdrawal of the 35 U.S.C. §112, second paragraph rejections of Claims 8-16.

Claim 17

Claim 17 appears rejected due to the Office's belief that the specification may not include structural support for complying with 35 U.S.C. §112, sixth paragraph. The Applicants believe that the specification already discloses the corresponding structure for performing the functions recited in Claim 17. As such, the Rejection has required the Applicants to state on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed functions recited in Claim 17. Provided below is a recitation of the Claims elements with associated page and line number references to corresponding structural features enabled by the specification.

Claim 17 recites a computer system. The structure for this computer system is provided at least by computer system 400 that is shown in Figure 4 and is described at least by page 15, line 1 - page 16, line 7. The specification explicitly indicates that computer system 400 can be utilized to implement rack equipment management information coordination method 100 and/or repository management component 320 (see page 14, lines 2-4). "[A] means for controlling automatic retrieval of rack equipment related information from at least one component comprising said rack equipment..." as recited in Claim 17, is provided at least by processor 451 which processes information and instructions, including instructions finding information for managing rack equipment information coordination and for rack equipment description retrieval

module 321 (see Figure 4 and at least page 15, lines 15-18). “[A] means for communicating said rack equipment related information for managing rack equipment while said rack equipment is in operation,” as recited in Claim 17, is provided at least by communication bus 457, communication port 459 and processor 451 (Figure 4); and interface module 325 that is part of repository management component 320 and which can be implemented with computer system 400 (see at least page 15, lines 2-9 and lines 3-23; and page 13, lines 7-13). “[A] means for storing said rack equipment related information and instructions for implementing rack equipment information coordination,” as recited in Claim 17, is provided at least by equipment description information repository 311 and/or management plan information repository 312 and instruction saving module 324 (see Figure 3). Per page 9, lines 14-16, the rack equipment description information and the rack equipment management plan can be stored on a computer readable medium. Per page 15, lines 15-19, instruction saving module can be implemented by processor 451 of computer system 400. See also page 12, lines 16-24; memory 452 and bulk storage 454 of Figure 4; page 15, lines 19-22. “[A] means for processing information and instructions,” as recited in Claim 17, is provided at least by processor 451 of computer system 400 (see Figure 4 and page 15, lines 15-19).

In light of at least the above identified structure in the specification that is associated with the elements of Claim 17, Applicants respectfully request withdrawal of the 35 U.S.C. §112, rejection of Claim 17.

Discussion of Rejection's Characterization of Claim Elements as
Non-Functional Descriptive Material

Applicants note that the Rejection has characterized portions of claim elements as Non-Functional Descriptive Material (NFDM). The Rejection has cited to *In re Gulack* (703 F.2d 1381) in its contention that certain portions of the Applicants' claims are non-functional descriptive material and thus "... can not render nonobvious an invention that would have otherwise been obvious," see page 12 and page 16 of the Rejection. Applicants submit that *In re Gulack* also admonishes that:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. *In re Gulack*, 703 F.2d 1381, 1395.

Applicants respectfully submit that the rejection has dissected Claims 8 and 17 by improperly categorizing certain portions as NFDM. For example, with respect to Claims 8 and 17 the Rejection has improperly indicated that "... the data or information such as '*wherein said equipment descriptive information comprises an identification of equipment type... rack of equipment*,'"' (emphasis in original) see pages 12 and 16 of the Rejection.

Applicants submit that the characterization is improper, because no analysis was provided other than an indication that each of claims 8 and 17 appeared to be a data processing method. Applicants respectfully submit that at least the following two factors should be considered. First, Applicants point out that Claim 8 is directed to a rack equipment coordination system and Claim 17 is directed to a computer system, neither of which is a data processing method as contended by the Rejection. Second, Claim 17 is a means + function type claim and the excised language is

descriptive of the function of the means. That is, one of Claim 17's elements is "a means for controlling automatic retrieval of ... an identification of equipment type of said at least ne component of a rack of equipment," (emphasis added). As such, Applicants submit that this underlined portion is not NFDM as it describes the function of the means. Similarly, Applicants submit that the excised portion of Claim 8 also describes the function of the "repository management component" that is recited in Claim 8. In light of this discussion, Applicants respectfully request examination of all of the language of the Claims.

Moreover, per MPEP 2173.05(g):

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) ... A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

35 U.S.C. §102 Rejections

Claims 8-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,336,919 to O'Kane, Jr., et al. (hereinafter referred to as "O'Kane"). The Applicants respectfully submit that the features recited in Claims 8-20 are not anticipated by O'Kane for at least the following rationale.

According to MPEP 2131, "to anticipate a claim, the reference must teach every element of the claim." Further, as cited in MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, according to MPEP 2131, “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claims 8-16

Attention is directed to Claim 8, which recites (emphasis added):

A rack equipment information coordination system comprising:
an equipment description information repository for tracking equipment description information, wherein said equipment description information comprises an identification of equipment type of at least one component of a rack of equipment, said equipment description information repository comprising physical bulk storage coupled with a computer;
a management plan information repository for tracking rack equipment management plan information, said management plan information repository comprising a second physical bulk storage coupled with said computer, wherein said rack equipment management plan information is used for managing rack equipment while said rack equipment is in operation and is configured for directing a change in operating characteristics of said rack equipment;
a coordination component for coordinating said equipment description information and said rack equipment management plan information, said coordination component comprising a processor of said computer programmed with instructions for performing said coordinating; and
a repository management component that controls automatic retrieval of said equipment description information and said management plan information such that said identification of equipment type is automatically retrieved by said repository management component from said at least one component of said rack of equipment, wherein said repository management component also controls population of said equipment description information into said equipment description information repository and population of said management plan information into said management plan information repository, said repository management component implemented by said processor of said computer which is programmed with instructions for performing said automatic retrieval and said population.

Applicants respectfully submit that the rejection of Claim 8 under 35 U.S.C. §102(b) is not proper, as the cited art does not meet the requirements set forth for anticipation (shown above) by the MPEP. Specifically, Applicants submit that O’Kane fails to anticipate Claim 8 and to meet the requirements for anticipation because it does not teach every element of Claim 8, as required by the MPEP.

For example, per Applicants’ understanding, O’Kane does not teach or suggest, either expressly or inherently, “a repository management component that controls automatic retrieval of said equipment description information and said management plan information such that said identification of equipment type is automatically retrieved by said repository management component from said at least one component of said rack of equipment ...,” (emphasis added) as is recited in Claim 8. To the contrary, automatic retrieval in O’Kane (if performed) appears to be limited to retrieving operation information (see col. 6, lines 40-53 of O’Kane) such as a DC power load rather than equipment description information such as equipment type. Applicants submit that to any extent that O’Kane discusses population or retrieval of equipment description information, such as identification of equipment type, O’Kane indicates such retrieval processes involve a survey request for manual collection and input of information. For example, O’Kane indicates:

The survey request imposes an acquisition of data by the technician as to a particular site 44 for insertion into the respective data bases. Either during or after the technician has visited the site 44 an electronic survey report 46 is prepared and forwarded via the network 24 to the computer 36 where the data is distributed into the appropriate databases...
O’Kane col. 4, lines 41-50).

Per Applicants' understanding, such manual retrieval and population of equipment identification information such as equipment type is very different than “a repository management component that controls automatic retrieval of said equipment description information and said management plan information such that said identification of equipment type is automatically retrieved by said repository management component from said at least one component of said rack of equipment ...,” (emphasis added) as is recited in Claim 8.

Accordingly, the Applicants submit that the rejection of Claim 8 under 35 U.S.C. §102(b) is not supported by the cited art as O’Kane does not teach all of the elements of Claim 8. Claims 9-16 depend from Claim 8 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants further submit that the rejection of Claims 9-16 under 35 U.S.C. §102(b) is also not supported by the cited art, at least by virtue of these claims depending from an allowable base claim. As such, Applicants submit that Claims 8-16 are in condition for allowance.

Claims 17-20

Attention is directed to Claim 17, which recites (emphasis added):

A computer system comprising:

a means for controlling automatic retrieval of rack equipment related information from at least one component comprising said rack equipment, wherein said rack equipment related information comprises rack equipment description information regarding at least said at least one component and includes an identification of equipment type of said at least one component of a rack of equipment;

a means for communicating said rack equipment related information for managing rack equipment while said rack equipment is in operation;

a means for storing said rack equipment related information and instructions for implementing rack equipment information coordination; and

a means for processing information and instructions, wherein said means for processing information and instructions is configured for processing said instructions and for managing operating characteristics of said rack equipment, and is configured for processing information for managing said rack equipment information.

Applicants respectfully submit that the rejection of Claim 17 under 35 U.S.C. §102(b) is not proper, as the cited art does not meet the requirements set forth for anticipation (shown above) by the MPEP. Specifically, Applicants submit that O’Kane fails to anticipate Claim 17 and to meet the requirements for anticipation because it does not teach every element of Claim 17, as required by the MPEP.

For example, per Applicants’ understanding, O’Kane does not teach or suggest, either expressly or inherently, “a means for controlling automatic retrieval of rack equipment related information from at least one component ... wherein said rack equipment related information comprises rack equipment description information regarding at least said at least one component and includes an identification of equipment type of said at least one component,” as is recited in Claim 17. To the contrary, automatic retrieval in O’Kane (if performed) appears to be limited to retrieving operation information (see col. 6, lines 40-53 of O’Kane) such as a DC power load. Applicants submit that to any extent that O’Kane discusses population or retrieval of equipment description information, such as identification of equipment type, O’Kane indicates that such processes involve a manual survey request for manual collection and input of information. For example, O’Kane indicates:

The survey request imposes an acquisition of data by the technician as to a particular site 44 for insertion into the respective data bases. Either during or after the technician has visited the site 44 an electronic survey report 46 is prepared and forwarded via the network 24 to the computer 36 where the data is distributed into the appropriate databases...

O’Kane col. 4, lines 41-50.

Per Applicants’ understanding, such manual retrieval and population of equipment information, such as equipment type, is very different than “a means for controlling automatic retrieval of rack equipment related information from at least one component ... wherein said rack equipment related information comprises rack equipment description information regarding at least said at least one component and includes an identification of equipment type of said at least one component,” (emphasis added) as is recited in Claim 17.

Accordingly, the Applicants submit that the rejection of Claim 17 under 35 U.S.C. §102(b) is not supported by the cited art as O’Kane does not teach all of the elements of Claim 17. Claims 18-20 depend from Claim 17 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants further submit that the rejection of Claims 18-20 under 35 U.S.C. §102(b) is also not supported by the cited art at least by virtue of these claims depending from an allowable base claim. As such, Applicants submit that Claims 17-20 are in condition for allowance.

35 U.S.C. §103 Rejections

Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over view of O’Kane. The Applicants respectfully submit that the features recited in Claims 1-7 are patentable over the cited art for at least the following rationale.

Obviousness Requirements

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)). Applicants note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141(III)).

Claims 1-7

Attention is directed to Independent Claim 1, which recites (emphasis added):

A computer-implemented rack equipment management information coordination method comprising:

formulating a rack equipment management plan that includes equipment management and usage policies and establishes an association between a rack equipment performance action and a trigger event, said formulating performed using a computer to analyze said equipment management and usage policies, wherein at least a portion of said equipment management and usage policies are automatically received by said computer from a customer database, and wherein said rack equipment management plan is a plan for managing rack equipment operating characteristics while said rack equipment is in operation;

automatically detecting and retrieving, with said computer, rack equipment description information from at least one component comprising said rack equipment, wherein said rack equipment description information comprises an identification of equipment type of said at least one component; and

storing, with said computer, said rack equipment description information and said rack equipment management plan.

Applicants submit that O’Kane does not teach or suggest “automatically detecting and retrieving, with said computer, rack equipment description information from at least one component comprising said rack equipment, wherein said rack equipment description information comprises an identification of equipment type of said at least one component,” as is recited in Claim 1. Applicants understand that O’Kane may describe automatically determining and monitoring a power load on a rack (see col. 6, lines 40-53 of O’Kane). However, Applicants submit that the automatic monitoring of O’Kane only automatically monitors operating information (such as a temperature or DC power load). Applicants submit this is very different than, and does not teach or suggest, “automatically detecting and retrieving, with said computer, rack equipment description information from at least one component comprising said rack equipment, wherein said rack equipment description information comprises an identification of equipment type of said at least one component,” as is recited in Claim 1. Furthermore, to any extent that O’Kane discusses population or retrieval of equipment operating information, such as equipment type, O’Kane indicates that such processes involve a survey request for manual collection and input of information. For example, O’Kane indicates:

The survey request imposes an acquisition of data by the technician as to a particular site 44 for insertion into the respective data bases. Either during or after the technician has visited the site 44 an electronic survey report 46 is prepared and forwarded via the network 24 to the computer 36 where the data is distributed into the appropriate databases...
O’Kane col. 4, lines 41-50.

Thus, per Applicants’ understanding, such manual retrieval and population of equipment information actually teaches away from “automatically detecting and retrieving, with said computer, rack equipment description information from at least one component comprising said

rack equipment, wherein said rack equipment description information comprises an identification of equipment type of said at least one component,” as is recited in Claim 1.

The Rejection also refers to retrieving data from databases such as 26 and 28 of O’Kane. However, Applicants submit that retrieving equipment information from a database is very different from, and does not teach or suggest, “automatically detecting and retrieving, with said computer, rack equipment description information from at least one component...,” as is recited in Claim 1.

Finally, the Rejection refers to col. 6, lines 15-30 and lines 40-53; col. 1, lines 25-46; and Figures 1 and 5. However, Applicants submit that these cited portions refer to a) manual surveys and information uploaded by technicians (see col. 2, lines 25-27; col. 2, lines 32-65; technician data 50 of Figure 1; battery data 108, temp. 104, humidity 106, and CFM 102 of Figure 5; and col. 5, lines 14-28); or b) automatic tracking of operational information such as a DC power load, temp., and humidity (see col. 6, lines 44-47 and Figure 5). Applicants submit that retrieving equipment information by manual survey or retrieving information such as DC power load, temperature, or humidity is very different from, and does not teach or suggest, “automatically detecting and retrieving, with said computer, rack equipment description information from at least one component...,” as is recited in Claim 1.

As such, Applicants submit that O’Kane fails to make a *prima facie* case of obviousness as not all of the features of Claim 1 are taught or suggested by the O’Kane and as further as O’Kane actually teaches away from Applicants’ Claim 1. Additionally, and as required by the

MPEP as cited above, the present Rejection fails to explain why the identified differences between Applicants' claimed invention and O'Kane would have been obvious to one of ordinary skill in the art.

Accordingly, the Applicants submit that the rejection of Claim 1 under 35 U.S.C. §103(a) has been overcome as O'Kane does not teach all of the elements of Claim 1 and actually teaches away from Claim 1. Claims 2-7 depend from Claim 1 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants further submit that the rejection of Claims 2-7 under 35 U.S.C. §103(a) is also overcome at least by virtue of these claims depending from an allowable base claim. As such, Applicants submit that Claims 1-7 are in condition for allowance.

CONCLUSION

In light of the above remarks, the Applicants respectfully request reconsideration and allowance of the pending Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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Date: 10/5/2009

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